UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,977	08/30/2001	Ken Kutaragi	100809-16280 (SCEW 18.970	7679

			EXAMINER
26304	7590	02/24/2005	ELMORE, JOHN E

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ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/942,977	KUTARAGI ET AL.
	Examiner	Art Unit
	John Elmore	2134

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *3/03,2/04,4/04*.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-17 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   **Claims 11 and 13 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.   A computer program per se is not a process, machine, manufacture, or composition of matter, but rather falls under the "abstract idea" exception. That is, a computer program claimed merely as a computer code or listing is not a tangible thing and, hence, is not statutory. For claims 11 and 13, no machine is claimed for the implementation of the computer program as further evidenced by the subsequent claims 12 and 14 which embody the computer program within a physical structure, notably a computer-readable recording medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   **Claims 1-15 and 17 are rejected under 35 U.S.C. 102(b)** as being anticipated

by Ginter et al., hereafter Ginter, (US Patent Number 5,892,900).

Regarding claim 1, Ginter teaches a method for monitoring utilization condition

of contents comprising the steps of:

equipping information gathering means on a network with which

a user terminal is allowed to connect, said user terminal carrying out information

processing by utilizing said contents (VDE on client processes contents usage metering

information and connects to server on the network; column 11, lines 36-56, and column

17, line 56, through column 18, line 5);

distributing digital information embedded in said contents to said user

terminal (column 17, lines 42-48, and column 18, lines 6-21), said digital information

causing said user terminal to transmit a contents utilizing history indicating said utilizing

condition of the contents to said information gathering means at a predetermined timing

while said user terminal is connected with said network (VDE on client monitors content

usage and reports usage history to server periodically; column 18, lines 1-6; column 18,

lines 22-24; column 33, lines 36-65; column 36, lines 10-43; column 137, lines 7-9; and

column 141, lines 35-56); and

creating utilizing information indicating how much the particular content is

utilized based on said contents utilizing history collected through said information

gathering means (column 35, lines 13-53; column 55, lines 44-51; column 150, lines 44,

through column 151, line 36).

Regarding claim 2, Ginter teaches a method for monitoring utilization condition

of contents comprising the steps of:

issuing a recording medium to a user operating a user terminal

which carries out information processing by utilizing said contents, said recording

medium having a data recording area for recording user identification data and a

nonvolatile memory area (VDE distributed to client on device with nonvolatile memory

on which to record usage history; column 17, lines 42-52; column 18, lines 6-21; column

40, line 62, through column 42, line 3);

equipping information gathering means on a network with which

said user terminal is allowed to connect (column 11, lines 36-56, and column 17, line

56, through column 18, line 5);

distributing digital information embedded in said contents to said user

terminal to which said issued recording medium is loaded (column 17, lines 42-52), said

digital information causing said user terminal to store a contents utilizing history

indicating said utilizing condition of the contents to said memory area (column 22, lines

14-25; column 33-65; column 133, lines 11-15 and 52-54; column 137, lines 7-9; and

column 141, lines 35-56), and to read said stored contents utilizing history so as to

transmit said contents utilizing history to said information gathering means along with

said user identification data at a predetermined timing while said user terminal is

connected with said network (column 18, lines 1-6; column 18, lines 22-24; column 36,

lines 10-43); and

creating utilizing information indicating how much the particular content is

utilized by which user based on said contents utilizing history and said user

identification data collected through said information gathering means (column 25, lines

28-35; column 33, lines 36-65; and column 150, line 44, through column 151, line 36).

Regarding claim 3, Ginter teaches all the limitations of claim 2, and further

teaches the step of authenticating whether said user terminal and said contents utilized

in said user terminal are proper or not, based on registered history data of transaction

indicating that said contents are properly transacted and also based on registered user

terminal identification data for authentication (column 11, lines 58-61; column 12, lines

31-37; column 21, lines 48-59; column 28, lines 17-42; and column 35, lines 13-53).

Regarding claim 4, Ginter teaches all the limitations of claim 3, and further

teaches the method wherein said authenticating step is executed on said user terminal

to which said recording medium is loaded by recording said user terminal identification

data to said data recording area of the recording medium and distributing said history

data of transaction along with said contents (client network ID and site ID identify client

terminal; column 25, lines 28-35; column 131, lines 28-61; and column 150, lines 49-

52).

Regarding claim 5, Ginter teaches all the limitations of claim 2, and further

teaches that said user terminal transmits said contents utilizing history to said

information gathering means on condition that the number of times of utilizing the same

content by the same user exceeds a predetermined number (budget sets limit on

number of times user can utilize the same content; column 21, lines 48-59; column 28,

lines 17-42; column 35, lines 13-53; column 59, lines 55-61; column 150, lines 44-52;

and column 154, lines 34-37).

Regarding claim 6, this claim constitutes a system version of the claimed

method steps above (claim 1), wherein all claim limitations have been addressed as set

forth above. Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claims 7-10, these claims constitutes a system version of the

claimed method steps above (claims 2-5), wherein all claim limitations have been

addressed as set forth above. Therefore, for the reasons applied above, such claims

also are anticipated.

Regarding claim 11, this claim constitutes a computer program version of the

claimed method steps above (claim 1), wherein all claim limitations have been

addressed as set forth above. Therefore, for the reasons applied above, such a claim

also is anticipated.

Regarding claims 12, this claims constitutes a computer-program-on-computer-

readable-recording-medium version of the claimed method steps above (claim 1),

wherein all claim limitations have been addressed as set forth above. Therefore, for the

reasons applied above, such claims also are anticipated.

Regarding claim 13, this claim constitutes a computer program version of the

claimed method steps above (claim 2), wherein all claim limitations have been

addressed as set forth above. Therefore, for the reasons applied above, such a claim

also is anticipated.

Regarding claims 14, this claims constitutes a computer-program-on-computer-

readable-recording-medium version of the claimed method steps above (claim 2),

wherein all claim limitations have been addressed as set forth above. Therefore, for the

reasons applied above, such claims also are anticipated.

Regarding claim 15, this claim constitutes a recording medium version of the

claimed method steps above (claim 2), wherein all claim limitations have been

addressed as set forth above. Therefore, for the reasons applied above, such a claim

also is anticipated.

Regarding claim 17, this claim constitutes a recording medium version of the

claimed method steps above (claim 3), wherein all claim limitations have been

addressed as set forth above. Therefore, for the reasons applied above, such a claim

also is anticipated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   **Claim 16 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Ginter.

Ginter teaches all the limitations of claim 15, and further teaches that a

transaction history data recording area for recording transaction history data, indicating

that said contents are properly transacted (column 18, lines 6-21; column 33, lines 36-

65; column 35, lines 13-53; column 40, line 62, through column 4, line 3). But Ginter

does not explain that the transaction history recording area is provided at a position accessible by said user terminal prior to at least said contents recording area.

However, Ginter teaches that the transaction history data recording area and the contents recording area exist on the same recording medium (column 17, lines 42-48). Arbitrarily, the former will occur either prior to or succeeding from the latter. Absent a showing of criticality as to the particular position of the transaction history data recording area in respect to the contents recording area, one of ordinary skill in the computer art at the time the invention was made would select the positioning the former prior to the latter with equal probability to its contravening format; therefore, the claim would have been obvious.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rabne et al. (US Patent Number 6,006,332) discloses a rights management system for digital media.

Stefik et al. (US Patent Number 5,634,012) discloses a system for reporting and controlling usage of digital content particularly requiring payment of a fee.

Apperson et al. (US Patent Number 5,978,484) discloses a method for monitoring the usage of distributable executable code and reporting that usage to a server.
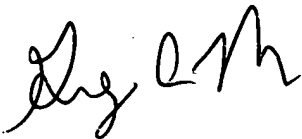
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Elmore whose telephone number is 571-272-4224. The examiner can normally be reached on M 10-8, T-Th 9-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JE

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